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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/049,927

03/30/98

ARNAUD

P

2350-60

HM12/0714

EXAMINER

B.J. SADOFF

HUANG, E

NIXON & VANDERHYE, P.C.

ART UNIT

PAPER NUMBER

1100 NORTH GLEBE ROAD

8TH FLOOR

1612

10

ARLINGTON VA 22201

DATE MAILED:

07/14/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/049,927

Applicant(s)
Arnaud

Examiner
Evelyn Huang

Group Art Unit
1612



☒ Responsive to communication(s) filed on Feb 17, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 13-37 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 13-37 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 8

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Claims 13-37 are pending. Claims 1-12 have been canceled according to the amendment filed on 2-17-99.
2. The 101 rejection for claims 1-4, 6-12 are withdrawn upon the cancellation of these claims.
3. The obviousness-type double patenting rejection for claim 5 is withdrawn in view of the cancellation of this claim.
4. The obviousness-type double patenting rejection for claims 13-37 over US patent no. 5648066 is withdrawn because it was an error, it is by different inventors and has a different assignee than the instant.
5. The 112 first paragraph rejection for claims 13-37 is maintained for reasons of record. Claims 13-37 have no antecedent basis in the specification and lack enablement in the original disclosure.

Applicant has cited the support for each of the claims and asserts that these claims are supported by enabling disclosure. In particular, for 'solid silicone composition for topical application to human skin or hair' of claim 13, Applicant has cited page 10, lines 9-10, directed to a cosmetic or dermatological compositions which can exist in various forms, such as oily gels, solid products such as compressed powders or sticks. However, the cited disclosure greatly departs from the solid silicone composition of polyethylene and non-volatile silicone fluid as exemplified in examples 1-3 (column 6, lines 1-29) and claimed by Stepniewski in the 5648066 patent, wherein the discovery that the low molecular weight polyethylene, i.e., polyethylenes having an average molecular weight of less than about 1000, are excellent solidifying agents for silicone fluids is disclosed (column 2, lines 51-55). The use of the polyethylene as a solidifying

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agent in a solid composition of silicone fluid and polyethylene as taught by Stepniewski has not been described or suggested in the instant specification. The instant claims 13-37 directed to a 'solid silicone composition' therefore has no antecedent basis and has failed to provide sufficient teaching and guidance to the skilled artisan to make and use the claimed invention without undue experimentation.

Further, applicant teaches away from Stepniewski's invention. While applicant does not describe the fatty phase of silicone oil and polyethylene wax as a solid, applicant specifically teaches that oily gel agents can be employed in the fatty phase of the composition, and charges, such as solid compounds in powder form may be added (page 8, lines 22-23; page 9, lines 5-10 of the specification), suggesting that the instant fatty phase of silicone oil and polyethylene wax is not in a solid form.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshioka (4990561, PTO-1449).

Yoshioka generically discloses a wax composition (columns 2-3) comprising a siloxane and an organic wax that is useful for cosmetic applications (column 8, lines 20-25). Yoshioka's composition has a macromonomer, which can be present in the instant composition due to the inclusive term 'comprises'. A specific composition comprising a siloxane and a polyethylene wax is described (columns 9-10, Table 1, examples 6, 8).

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The reference examples differ from the instant in that the molecular weight of the polyethylene is not recited. However, the polyethylene within the claimed range are well known in the art. At the time of the invention, one of ordinary skill in the art would be motivated to replace the commercially available polyethylene in the reference example with the polyethylene of molecular weight of 500 or less to arrive at the instant invention with the reasonable expectation of attaining a highly uniform and stable silicone-containing wax composition since Yoshioka had clearly taught that any organic wax within the generic disclosure would be effective.

Yoshioka (column 6, lines 61-66) also teaches the inclusion of the various additives recited in the instant claims. One of ordinary skill in the art would be motivated by Yoshioka to add the particular additives to the reference example composition to arrive at the instant invention. To the skilled artisan, addition of known compounds to a composition to obtain the known benefits and properties thereof is prima facie obvious in the absence of unexpected results.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn Huang whose telephone number is (703) 305-7247.


EVELYN MEI HUANG
PRIMARY EXAMINER

July 9, 1999